

REMARKS

Prior to entry of this Amendment, claims 1-32 are pending in the application; however,

- claims 24 and 32 have been withdrawn from consideration as being drawn to an unelected invention; and
- claims 6-7 have been withdrawn from consideration as being drawn to an unelected species of the elected invention under examination.

Claims 1 and 25 are the independent claims under consideration.

All pending claims stand rejected as follows:

- claims 1-23 under 35 U.S.C. 112, second paragraph, as being indefinite;
- claims 1, 9, 11, 12, 25, and 30 under 35 U.S.C. §102(b) as anticipated by the Japanese patent publication No. JP 1-265979;
- claims 1, 8, 9, 18, 19, 22, 23, 25, and 29-31 as anticipated by U.S. Patent No. 6,206,795 to Ou (“Ou ‘795”);
- claims 1, 9, 18, 19, 22, 25, 29, and 30 as anticipated by U.S. Patent No. 5,772,545 to Ou (“Ou ‘545”);
- claims 1, 21, and 25-30 under 35 U.S.C. §102(b) as anticipated by International Application Publication No. WO 99/15242 by Shishido *et al.* (“Shishido”);
- claims 2-4 under 35 U.S.C. §103(a) as unpatentable over Ou ‘795 in view of U.S. Patent No. 5,624,517 to Giesen *et al.*;
- claims 13-14 under 35 U.S.C. §103(a) as unpatentable over Ou ‘795 in view of U.S. Patent No. 4,157,424 to Boutle (“Boutle”) and British patent publication No. GB 1,095,969;
- claims 20-21 under 35 U.S.C. §103(a) as unpatentable over Ou ‘795; and
- claims 5, 10, 13-17, 26, and 27 as unpatentable over JP 1-265979, either alone or in view of Ou ‘795, Boutle, and GB 1,095,969.

Applicants thank Examiner Musser for her time and courtesy extended during a telephonic interview with the undersigned attorney on October 14, 2005, and for the helpful suggestions with respect to claim amendments. In addition, Applicants note with appreciation the guidance provided by the Examiner in the Office action, and is grateful for the opportunity to discuss the proposed claim amendments and the scope of the cited art. The following is intended to constitute a proper recordation of the interview in accordance with M.P.E.P. §713.04, and also to provide a full response to the Office action.

The discussion during the interview focused on claims 1, 16 and 25, as well as on the differences between the present invention and the prior art cited in the Office action. Consistent with this discussion, Applicants have amended claims 1, 11, 16 and 25 and respectfully submit that Ou '795, or any other reference of record, either alone or in proper combination, does not teach or suggest the inventions defined by the amended claims. No new matter has been introduced by these amendments, support being found in the claims, as originally filed, as well as throughout the specification, at least in paragraph [0028] and FIG. 4. In addition, Applicants have cancelled without prejudice claims 24 and 32 drawn to the nonelected invention.

Also, Applicants hereby amend the title of the invention, so that it is more specifically descriptive of various embodiments of the claimed invention.

In view of the above amendments and following remarks, reconsideration and withdrawal of all grounds of rejection are respectfully requested.

1. Claims 1, 8, 9, 11, 12, 18, 19, 21, 22, 23, and 25-31 stand rejected under 35 U.S.C. §102(b) as being anticipated by at least one of JP 1-265979, Ou '795, Ou '545, and Shishido. Applicants respectfully traverse this rejection to the extent it is maintained over the claims, as amended.

In order for a claim to be anticipated under 35 U.S.C. §102(b), each and every limitation thereof must be found in a single reference. Applicants respectfully submit that each of the cited references fails to meet this exacting standard with respect to independent claims 1 and 25 and the claims that depend either directly or indirectly therefrom.

Claims 1, 8, 9, 11, 12, 18, 19, 21, 22, 23

Applicants have amended independent claim 1 to clarify that the claimed method of manufacturing a multi-layer outer panel for a game ball includes three-dimensionally forming a generally convex top layer and at least one generally convex backing layer. None of the cited references teaches or suggests these features. Rather, each of the cited references discloses flat cover panels that assume a convex shape once assembled to form a ball. See, for example, FIG. 3 of JP 1-265979, col. 4, lines 39-40 and FIG. 7 of Ou '545, col. 3, lines 10-40 of Ou '795, as well as FIGS. 5-6 and corresponding text of Shishido.

More specifically, addressing the Examiner's concerns raised during the October 14, 2005, interview with respect to Ou '795, Applicants respectfully submit that this reference is utterly silent with respect to the curvature of the cover panels. Moreover, Applicants note that Ou '795 teaches that its cover panels are "structured as the conventional [prior art] panels." See col. 3 line 65 to col. 4, line 2. As recognized by the Applicants in the specification and as represented by the prior art of record in this application, conventional panels for game balls are flat and assume a convex shape only after being assembled together or disposed over a bladder or other underlying supporting structure to form a ball.

Turning to the apparent reliance on the drawings of Ou '795 by the Examiner, Applicants submit that FIGS. 2-6 of Ou '795 depict various views of the assembled basketball or portions thereof, rather than the cover panels as fabricated prior to the final assembly. Moreover, with respect to FIGS. 7A-7D, as a matter of law, supposed proportions of features in drawings are not evidence of actual proportions when the drawings are not to scale. For example, when a reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See M.P.E.P. §2125 (8th ed., August 2001). See also, Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc., 2000 U.S. App. LEXIS 18139; 55 U.S.P.Q. 2d (BNA) 1487 (Fed. Cir. 2000)(patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue).

Here, Ou '795 is completely silent both as to whether the drawings are to scale and as to the curvature of the panels, once fabricated. Moreover, Ou '795 does not indicate whether the panels of FIGS. 7A-7D are depicted before or after attachment thereof to the underlying supporting structure of the basketball. In accordance with the M.P.E.P. and case law, therefore, it is improper to glean from this reference that the panels are manufactured by being formed generally convex, as recited in the amended claim 1. Notably, Ou '795 discloses in detail a variety of features of the panels, including specific configuration of the edges, the panels' contour, as well as overall thickness of the panels and its component layers, but does not address their curvature.

Thus, Applicants respectfully submit that each of JP 1-265979, Ou '795, Ou '545, and Shishido does not teach or suggest a method of manufacturing a multi-layer outer panel for a game ball that includes three-dimensionally forming a generally convex top layer and at least one generally convex backing layer, as recited in Applicants' amended claim 1.

Accordingly, Applicants respectfully submit that independent claim 1, as amended, is allowable over the art of record. Because claims 8, 9, 11, 12, 18, 19, 21, 22, 23 depend either directly or indirectly from this independent claim and include further limitations thereon, Applicants submit that these claims are allowable over the art of record, as well. Reconsideration and withdrawal of the rejection of claims 1, 8, 9, 11, 12, 18, 19, 21, 22, 23 under 35 U.S.C. §102(b) are respectfully requested.

Claims 25-31

Applicants have amended independent claim 25 to clarify that the claimed method of manufacturing a game ball includes providing a plurality of multi-layer panels, wherein each panel is formed in a generally convex shape prior to being interconnected with adjacent panels over a substantially spherical bladder. Thus, the outer surface of the generally convex top layer of each panel is dimensioned to substantially correspond to a section of a surface of the ball prior to being disposed over the bladder. As discussed above, none of the cited references teaches or suggests providing such generally convex multi-layer panels, because each of JP 1-265979, Ou

‘795, Ou ‘545, and Shishido discloses flat panels that assume a convex shape only after being disposed over an underlying structure to form a ball.

Accordingly, Applicants respectfully submit that independent claim 25, as amended, is allowable over the art of record. Because claims 26-31 depend either directly or indirectly from this independent claim and include further limitations thereon, Applicants respectfully submit that these claims are allowable over the art of record, as well. Reconsideration and withdrawal of the rejection of claims 25-31 under 35 U.S.C. §102(b) based on JP 1-265979, Ou ‘795, Ou ‘545, and Shishido are respectfully requested.

2. Dependent claims 2-5 10, 13-17, and 20-21, stand rejected under 35 U.S.C. §103(a) as unpatentable over Ou ‘795, either alone or in view of one or more of Giesen, Boutle, and GB 1,095,969. In addition, dependent claims 26-27 stand rejected under 35 U.S.C. §103(a) as unpatentable over JP 1-265979, either alone or in view of Ou ‘795, Boutle, and GB 1,095,969.

Without acquiescing to these rejections, Applicants note that these claims depend directly from the amended independent claims 1 and 25, and include all the limitations thereof, and thus, are also patentable for the same reasons those independent claims are patentable. None of Giesen, Boutle, or GB 1,095,969 cure the deficiencies of the primary references with respect to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2-5, 10, 13-17, 20-21, 26, and 27 under 35 U.S.C. § 103(a).

3. Claims 1-23 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully traverse this rejection to the extent it is maintained over the claims, as amended. Specifically, Applicants have amended claims 1 and 16 in the manner discussed during the interview to correct the claim language and submit that these claims properly comply with 35 U.S.C. §112, second paragraph. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-23 under 35 U.S.C. §112, second paragraph.

CONCLUSION

Applicants respectfully submit that claims 1-5, 8-23, and 25-31 are in condition for allowance, and request that application proceed to issue. If, in the Examiner's opinion, a telephonic interview would expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,



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